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22 UNITED STATES DISTRICT COURT
23 SOUTHERN DISTRICT OF CALIFORNIA

24 GEN-PROBE, INCORPORATED,

25 Plaintiff,

26 v.

27 VYSIS, INC.,

28 Defendant.

CASE NO. 99CV 2668H (AJB)

**APPLICATION FOR EXPEDITED
BRIEFING AND HEARING OF VYSIS'
MOTION FOR ENTRY OF FINAL
JUDGMENT UNDER RULE 54(b)**

29 On June 29, 2001, Vysis filed and served its Motion for Entry of Final Judgment Under Rule
30 54(b) ("the 54(b) Motion"). Pursuant to Local Rule 7.1(e)(1), the 54(b) Motion is set for hearing on
31 July 30, 2001. Because of the time-sensitive nature of the relief sought in the 54(b) Motion, Vysis
32 now seeks expedited briefing and hearing of that motion. Vysis and Gen-Probe have discussed and
33 agreed upon a proposed briefing schedule, and Gen-Probe has indicated that it does not oppose this
34 application for expedited briefing and hearing.

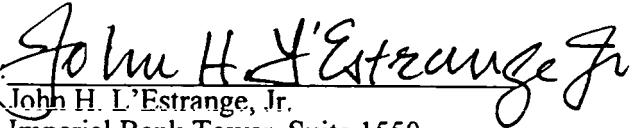
1 Vysis' 54(b) Motion seeks entry of final judgment as to Counts I and III of Gen-Probe's
2 Second Amended Complaint, as well as a stay of the remaining proceedings, so Vysis may appeal
3 the Court's grant of Gen-Probe's motion for summary judgment on noninfringement to the Court of
4 Appeals for the Federal Circuit. Currently, the parties have numerous depositions scheduled over
5 the next few weeks. If this Court were to grant Vysis' 54(b) Motion and stay the remaining
6 proceedings in this case during the appeal to the Federal Circuit, those depositions could be deferred
7 until after resolution of the appeal, or even rendered moot should the Federal Circuit affirm this
8 Court's grant of summary judgment. Accordingly, an expedited hearing of Vysis' 54(b) Motion will
9 allow the parties to save time and resources that might otherwise be wasted should the depositions
10 proceed in accordance with the normal briefing and hearing schedule.

11 Vysis and Gen-Probe have agreed that Gen-Probe's Opposition to Vysis' 54(b) Motion
12 would be filed by July 10, 2001, Vysis' Reply would be filed by July 13, 2001, and any hearing, if
13 required, could be as soon after July 13, 2001 as is practicable for the Court. Further, the parties
14 have agreed that the remaining depositions could be postponed until after Vysis' 54(b) Motion is
15 ruled upon. The parties are aware that fact discovery is set to close on July 19, 2001, but are willing
16 to go beyond that date until all the depositions have been completed. The parties are also willing to
17 adjust the date on which expert reports are due to accommodate the additional time needed to
18 complete the depositions of the fact witnesses. The parties do not seek a change of the trial date or
19 the dates of other pretrial activities other than those relating to fact and expert discovery.

1 Because of the savings of time and resources that could result from an expedited hearing of
2 Vysis' 54(b) Motion, and in light of the parties' agreement to an expedited briefing schedule, Vysis
3 respectfully requests grant of this application. A proposed order is attached hereto.
4

5 Dated: July 2, 2001

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7 By: 
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1 **Gen-Probe, Incorporated v. Vysis, Inc.**
2 **United States District Court, Southern District of California, Case No. 99CV2668H (AJB)**

3 **PROOF OF SERVICE BY FAX**

4 I, the undersigned, declare: I am over the age of 18 and not a party to the within action; I am
5 employed in, or am a resident of, the County of San Diego, California, from which the facsimile was
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8 **APPLICATION FOR EXPEDITED BRIEFING AND HEARING OF VYSIS'
9 MOTION FOR ENTRY OF FINAL JUDGMENT UNDER RULE 54(b)**

10 **[PROPOSED ORDER GRANTING APPLICATION FOR EXPEDITED
11 BRIEFING AND HEARING OF VYSIS' MOTION FOR ENTRY OF FINAL
12 JUDGMENT UNDER RULE 54(b)]**

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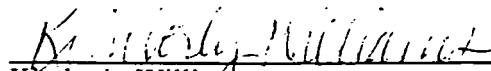
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5 I am employed in, or am a resident of, the County of San Diego, California, and my business address
6 is: 4665 Park Blvd., San Diego, California 92116.

7 On July 2, 2001, I served the following document(s):

8 **APPLICATION FOR EXPEDITED BRIEFING AND HEARING OF VYSIS'
9 MOTION FOR ENTRY OF FINAL JUDGMENT UNDER RULE 54(b)**

10 **[PROPOSED ORDER GRANTING APPLICATION FOR EXPEDITED
11 BRIEFING AND HEARING OF VYSIS' MOTION FOR ENTRY OF FINAL
12 JUDGMENT UNDER RULE 54(b)]**

13 by personally serving copies of said documents upon the following individuals at the following
14 addresses or by leaving copies at the office listed below, in an envelope or package clearly labeled
15 to identify the person being served, with a receptionist or, with a person having charge thereof:

14 **Patrick Maloney**
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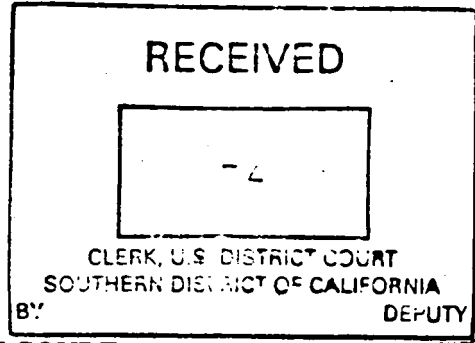
19 I declare under penalty of perjury under the laws of the State of California that the foregoing
20 is true and correct.

21 Executed on July 2, 2001 in San Diego, California.

22 **DIVERSIFIED LEGAL SERVICES, INC.**

23 By 
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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

GEN-PROBE, INCORPORATED,

Plaintiff,

v.

VYSIS, INC.,

Defendant.

CASE NO. 99CV 2668H (AJB)

**[PROPOSED] ORDER GRANTING
APPLICATION FOR EXPEDITED
BRIEFING AND HEARING OF VYSIS'
MOTION FOR ENTRY OF FINAL
JUDGMENT UNDER RULE 54(b)**

Vysis' Application for Expedited Briefing and Hearing of its Motion for Entry of Final Judgment of Rule 54(b) is GRANTED. Gen-Probe's Opposition to Vysis' motion will be filed by July 10, 2001, Vysis' Reply will be filed by July 13, 2001, and the hearing on Vysis' motion will be set for oral argument on July ___, 2001.

IT IS SO ORDERED.

Date: _____

JUDGE OF THE DISTRICT COURT

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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

GEN-PROBE, INCORPORATED,

Plaintiff,

v.

VYSIS, INC.

Defendant.

Case No. 99CV 2668H(AJB)

**STIPULATION RE EXPEDITED
BRIEFING SCHEDULE ON VYSIS'
MOTION FOR ENTRY OF FINAL
JUDGMENT UNDER RULE 54(B),
[PROPOSED] ORDER THEREON**

WHEREAS, on June 29, 2001, Vysis filed a Motion For Entry Of Final Judgment Under Rule 54(b) ("Vysis' Motion"); and

WHEREAS, the parties have agreed to an expedited briefing schedule on Vysis' Motion.

The parties hereby stipulate, by and through their respective counsel, that Gen-Probe's Opposition to Vysis' Motion will be filed by July 10, 2001, Vysis' Reply will be filed by July 13, 2001, and the hearing on Vysis' Motion, if required, will be as soon after July 13, 2001 as is practicable for the Court.

202120" 906E560

1 IT IS SO STIPULATED

2

3 Date: July 2, 2001

4

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Attorneys for Defendant
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11 Date: July ____, 2001

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14

15

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By: _____
Stephen P. Swinton

17

Attorneys for Plaintiff
GEN-PROBE INCORPORATED

18

19

20 IT IS SO ORDERED.

21

Vysis' Motion For Entry Of Final Judgment Under Rule 54(b) will be set for oral argument
on July ____, 2001.

22

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Date: _____

JUDGE OF THE DISTRICT COURT

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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

GEN-PROBE INCORPORATED,

Plaintiff,

v.

VYSIS, INC.,

Defendant.

No. 99cv2668 H (AJB)

**GEN-PROBE INCORPORATED'S OPPOSITION TO
MOTION FOR ENTRY OF FINAL JUDGMENT
UNDER RULE 54(B)**

Date: July 30, 2001
Time: 10:30 a.m.
Dept.: Courtroom 1

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10 *Curtiss-Wright Corp. v. General Elec.*,
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Federal Rule of Civil Procedure, Rule 54(b) *passim*

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1 Vysis seeks to suspend this case in the same manner it began – by seeking once more to
2 have this Court stay the action for an indeterminate amount of time while it collects royalties in the
3 interim. See Order Denying Motion for Stay, Ex. 1.¹ For the reasons set forth in Judge Enright’s
4 opinions in *Sure-Safe Industries, Inc. v. C&R Pier Mfg.*, 851 F.Supp. 1469 (S.D. Cal. 1993) and
5 *Lockwood v. American Airlines, Inc.*, 1993 WL 643369 (S.D. Cal. 1993), the Court should deny
6 Vysis’ motion for entry of judgment pursuant to Federal Rule of Civil Procedure, Rule 54(b).

7 **I. THE COURT’S ORDER GRANTING PARTIAL SUMMARY JUDGMENT DOES NOT**
8 **CONSTITUTE AN COMPLETE ADJUDICATION OF ANY CLAIM IN THE ABSENCE OF A**
9 **COMPLETE CONCESSION BY VYSIS ON THE DOCTRINE OF EQUIVALENTS.**

10 The first step in consideration of a motion pursuant to Rule 54(b) is to determine whether
11 there has been a final adjudication of any cause of action. *Curtiss-Wright Corp. v. General Elec.*,
12 446 U.S. 1, 7-8 (1980); *Sears, Roebuck & Co. v. Mackey*, 351 U.S. 427, 436 (1956).

13 In Count One of its Second Amended Complaint (Vysis’ Exhibit A), Gen-Probe asserts a
14 cause of action for declaratory judgment of non-infringement. On June 19, 2001, this Court
15 granted partial summary judgment in this case, finding that Gen-Probe’s nucleic acid test for HIV
16 and hepatitis C virus is not covered by the literal language of the claims of the ‘338 patent. See
17 Order Granting Motion for Partial Summary Judgment, Ex. 2. The Court’s order granting partial
18 summary judgment does not completely resolve Count One.² Complete determination of the issue
19 of non-infringement requires consideration of both literal infringement *and* infringement under the
20 doctrine of equivalents. *Roton Barrier, Inc. v. Stanley Works*, 79 F.3d 1112, 1125 (Fed. Cir.
21 1996). Because Gen-Probe’s motion did not address the issue of infringement pursuant to the
22 doctrine of equivalents (See Order Granting Partial Summary Judgment, p. 11, Ex. 2), Count One
23 has not been completely adjudicated.

24 Vysis seeks to finesse this problem by stating that it “has no reasonable expectation of
25 prevailing at trial on the issue of infringement if the Court’s claim construction is sustained.” See

26 ¹ All exhibits cited herein are attached to the concurrently filed Notice of Lodgment of Exhibits in
27 Support of Gen-Probe Incorporated’s Opposition to Motion for Entry of Final Judgment Under
28 Rule 54(b).

² While Vysis suggests that the Court’s ruling also resolves Count Three for declaratory relief, that
count raises the issue of patent invalidity as well as the issue of whether the ‘338 patent covers
Gen-Probe’s products and is not resolved by the Court’s order on literal infringement.

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1 Vysis Memorandum at 2:2-4. By this statement, Vysis implicitly suggests that it is unlikely to
2 prevail on the doctrine of equivalents. However, this oblique statement of probable outcomes is
3 *not* sufficient to transform the Court's order into a complete adjudication of Count One. Vysis'
4 statement does not specifically address the doctrine of equivalents, nor does it make a binding
5 concession on that issue for purposes of Rule 54(b). Vysis' statement is therefore inadequate to
6 fully dispose of the issue of infringement under the doctrine of equivalents. *See CAE*
7 *Screenplates, Inc. v. Heinrich Fiedler GmbH & Co.*, 224 F.3d 1308, 1314-1316 (Fed. Cir. 2000).

8 In *CAE Screenplates*, two separate and potentially-infringing devices (the "Bar Screen" and
9 the "Top Screen") were at issue. Defendant successfully moved for partial summary judgment of
10 non-infringement as to the Bar Screen. 224 F.3d at 1314. In seeking entry of final judgment,
11 plaintiff stated that the court's holding "appears to relate not only to the Bar Screen . . . but also to
12 the Top Screen. In view of the present disposition of the case, no factual infringement issue for a
13 jury to determine remains." *Id.* The plaintiff further stated that its submission was "not an
14 admission that there is no infringement, but rather a statement that it appears that if the Court
15 interprets the claims and prosecution history as it has in its order of December 17, 1998, then the
16 Court's decision on the Top Screen would be the same (non-infringement) as on the Bar Screen."
17 *Id.*

18 The Federal Circuit concluded that CAE's concession was "non-committal" and pointed
19 out that:

20 CAE could have avoided any confusion by explicitly declaring that
21 'given the district court's construction of the claims, we concede
22 non-infringement by the Top Screen plates.' Had it made this
concession, no outstanding issues [concerning infringement] would
remain before the district court.

23 224 F.3d at 1315. The court added that:

24 The court is loath to sanction this type of appellate practice. The
25 demands placed on the dockets of both this court and those of the
26 federal district courts are severe enough without the added burden
created by *uncertain concessions made by parties eager for
appellate review.*

27 *Id.* (emphasis added). The Federal Circuit recognized that CAE's counsel had finally made an
28 express, binding concession during appellate argument, which the court said would have been

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1 "more appropriate had it been made before the district court." *Id.* at 1316.

2 Here, as in *CAE Screenplates*, Count One for non-infringement will not be fully resolved
3 unless Vysis explicitly states that "Given the Court's construction of the claims of the '338 patent,
4 Vysis concedes non-infringement under the doctrine of equivalents." An ambiguous statement
5 that refers only to the "probability" of the ultimate outcome on the issue of infringement, and does
6 not even reference the doctrine of equivalents, is not adequate by itself to fully resolve Count One
7 for purposes of Rule 54(b). In the absence of a complete concession, no cause of action has been
8 finally adjudicated and there is no partial judgment to be certified under Rule 54(b).

9 **II. EVEN IF VYSIS CONCEDES ON THE DOCTRINE OF EQUIVALENTS, THE ADJUDICATION OF**
10 **COUNT ONE SHOULD NOT BE CERTIFIED PURSUANT TO RULE 54(B).**

11 Assuming that Vysis concedes on the doctrine of equivalents, the second question³ raised
12 by the present motion is whether there is "no just reason for delay" in the entry of final judgment
13 on Count One, such that the Court should -- as a matter of discretion and sound judicial
14 management -- grant an exception from the policy against piecemeal appeals.

15 The Court's order granting partial summary judgment does not determine whether the '338
16 patent is valid. Counts Two, Three, Four, Five and Six of Gen-Probe's Second Amended
17 Complaint each assert that the '338 patent is invalid and Gen-Probe continues to prosecute those
18 causes of action. (Gen-Probe is clearly entitled to show in connection with Count Four for unfair
19 competition that Vysis threatened enforcement of a patent that not only did not cover Gen-Probe's
20 technology, but was also invalid and/or unenforceable.) Entry of judgment on Count One under
21 Rule 54(b), when the invalidity issues remain pending, would result in an inefficient use of judicial
22 resources and unnecessary delay in the ultimate resolution of this case.

23 There is a long-standing policy in the federal courts against piecemeal disposition of
24 litigation. *See Hohorst v. Hamburg-American Packet Co.*, 148 U.S. 262 (1893); *Woodard v. Sage*
25 *Products, Inc.*, 818 F.2d 841, 845 (Fed. Cir. 1987) (en banc). Nevertheless, the drafters of the
26 Federal Rules of Civil Procedure recognized that, in some situations, entry of partial final

27 ³ In *Sears*, 351 U.S. 427, the Supreme Court outlined the general framework for analysis of a
28 motion seeking relief under Rule 54(b). First, the district court must determine whether there is a
final judgment as to any cause of action. *Sears*, 351 U.S. at 436. Second, the district court must
determine whether there is any just reason for delay in pursuing an appeal. *Id.*

1 judgment may be necessary “to avoid the possible injustice of a delay in judgment of a distinctly
2 separate claim to await adjudication of the entire case.” Fed.R.Civ.P. 54(b), Note of Advisory
3 Committee on Rules, 1946 Amendment. For this reason, Rule 54(b) authorizes entry of partial
4 final judgment in some circumstances.

5 However, Rule 54(b) “preserves the historic federal policy against piecemeal appeals.”
6 *Sears*, 351 U.S. at 438. The Federal Circuit has made clear that a trial court should deny a request
7 for certification under Rule 54(b) where the moving party “has failed to disclose any ‘serious,
8 perhaps irreparable, consequence’ flowing from the partial summary judgment and denial of [it’s]
9 Rule 54(b) motion.” *Chaparral Communications, Inc. v. Boman Indus., Inc.*, 798 F.2d 456 (1986)
10 quoting *Carson v. American Brands, Inc.*, 450 U.S. 79, 84 (1981); see also *Morrison-Knudsen Co.*
11 *v. J.D. Archer*, 655 F.2d 962, 965 (9th Cir. 1981) (“Judgments under Rule 54(b) must be reserved
12 for the unusual case”)⁴. Therefore, piecemeal appeals remain disfavored and “it has been widely
13 recognized that orders under [Rule] 54(b) ‘should not be entered routinely or as a courtesy or
14 accommodation to counsel.’” *Pharmacia Inc. v. Frigitonics Inc.*, 1990 U.S. Dist. Lexis 19439, at
15 *4 (D. Mass. 1990).

16 Where issues of non-infringement and invalidity are presented in a patent case, the court
17 should consider both issues and should not dispose of the case on non-infringement grounds alone.
18 The Supreme Court has recognized the need to adjudicate both issues:

19 There has been a tendency among the lower federal courts in
20 infringement suits to dispose of them where possible on the ground
21 of non-infringement without going into the question of validity of
22 the patent. It has come to be recognized, however, that of the two
questions, validity has the greater public importance, and the District
Court in this case followed what will usually be the better practice
by inquiring fully into the validity of this patent.

23 *Sinclair & Carroll Co. v. Interchemical Co.*, 325 U.S. 327, 330 (1945). For this reason, the
24 Supreme Court required the Federal Circuit to abandon its practice of vacating judgments of patent
25 invalidity, as moot, whenever it affirmed judgments of non-infringement. *Cardinal Chemical Co.*
26 *v. Morton International, Inc.*, 508 U.S. 83 (1993).

27
28 ⁴ Ninth Circuit precedent controls procedural issues not related to patent law in patent cases filed
in district courts within the Ninth Circuit. *CAE Screenplates Inc.*, 224 F.3d at 1314-15.

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1 Thus, when claims of invalidity and non-infringement are presented in a case, entry of
2 judgment on the non-infringement claim alone is generally not appropriate under Rule 54(b).
3 *Lockwood v. American Airlines, Inc.*, 1993 WL 643369, *Sure-Safe Industries, Inc. v. C&R Pier*
4 *Mfg.*, 851 F.Supp. 1469.

5 In both *Lockwood* and *Sure-Safe*, Judge Enright denied Rule 54(b) motions on facts and
6 arguments nearly identical to those presented here. In *Lockwood*, the court granted summary
7 judgment of non-infringement. Although a counterclaim for patent invalidity remained pending,
8 plaintiff *Lockwood* sought to appeal immediately. *Lockwood* argued that the non-infringement
9 order mooted defendants' invalidity cause of action, that the invalidity and non-infringement
10 counts were legally and factually distinct and separable, and that it would be most efficient to
11 allow an immediate appeal.

12 Judge Enright first noted that "Judgment under Rule 54(b) must be reserved for the unusual
13 case in which the costs and risks of multiplying the number of proceedings and of overcrowding
14 the appellate docket are outbalanced by pressing need of the litigants for an early and separate
15 judgment." 1993 WL 643369, at *1. Citing *Cardinal Chemical Co.*, 508 U.S. 83, the court then
16 recognized that "the Supreme Court has recently indicated its preference for that district courts rule
17 on both the invalidity and infringement issues, even when non-infringement is found." 1993 WL
18 643369, at *1.

19 The court found that *Lockwood* had "presented no evidence or argument which suggests
20 that this is an unusual case warranting relief under Rule 54(b)." The court concluded that:

21 The arguments made by plaintiff are the same arguments that could
22 be made in every patent case. In light of the direction provided by
23 the Supreme Court in *Cardinal Chemical*, this court finds that
granting plaintiff's Rule 54(b) motion would only unnecessarily
delay resolution of this case.

24 1993 WL 643369, at *2. The Federal Circuit endorsed Judge Enright's reasoning in its opinion on
25 related issues, noting that "our cases encourage district courts to adjudicate questions of both
26 infringement and validity when both are raised, without reference to the order in which the are
27 raised. The Supreme Court has expressed the same general preference." *In re Lockwood*, 50 F.3d
28 966, 969 n. 2 (Fed. Cir. 1995), *vacated by* 515 U.S. 1182 (1995) (citations omitted).

1 Similarly, in *Sure-Safe*, plaintiffs sought immediate appellate review of an order granting
2 defendant's motion for summary judgment on plaintiff's patent infringement cause of action.
3 Counterclaims for patent invalidity remained pending. In considering the Rule 54(b) motion,
4 Judge Enright recognized that "[i]nterlocutory appeal should be granted only to avoid serious
5 consequences." 851 F.Supp. at 1475. The court concluded that:

6 Plaintiffs have failed to demonstrate any immediate hardship or
7 injustice to justify a Rule 54(b) certification. Plaintiffs' request
8 seeks to advance the convenience of the plaintiffs' and their counsel
and to avoid the remote possibility of a second trial. This is not
sufficient urgency to justify a Rule 54(b) certification.

9 *Id.* The court also found that an immediate interlocutory appeal would not be more efficient than
10 first completing the entire case in the district court:

11 This court disagrees that efficiencies will be gained by allowing an
12 immediate appeal. In light of the proximity of trial, and the long
13 delay in obtaining an appellate opinion, granting Rule 54(b)
14 certification would not expedite the conclusion of this action.
15 Rather, it would be more efficient to develop a full factual record
16 and permit all the appeals to be taken at once. Finally, this court
does not believe that the motion for summary judgment on
infringement was incorrectly decided. Therefore, permitting a
piecemeal appeal would probably be a waste of time which could be
as long as two years.

17 *Id.* at 1475-76.

18 Vysis' reliance on *Loral Fairchild Corp. v. Victory Co.*, 931 F. Supp. 1044 (E.D.NY. 1996)
19 is misplaced. *Loral* was a multiparty patent litigation involving "numerous" defendants and "more
20 than 150 products and many processes." The court separated the matter into six separate trials.
21 Following the first trial on all issues through jury verdict and post-trial motions, Judge Rader
22 certified an immediate appeal of the judgment in that case under Rule 54(b).

23 *Loral* and this case are not comparable in any material respect. In *Loral*, all claims
24 between some parties had been finally decided by trial and post-trial motions on all issues. The
25 court decided that the result, being complete as between the parties to the first trial, should be
26 certified prior to commencement of separate trials against other parties in the interest of judicial
27 efficiency.

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1 Vysis has failed to cite a single case in which a summary judgment of non-infringement
2 has been certified under Rule 54(b) over the objection on an opposing party when invalidity issues
3 remained pending between the parties.⁵ *Lockwood* and *Sure-Safe* apply here. Issues of patent
4 validity should be resolved prior to any appeal so that this case may be reviewed in its entirety by
5 way of a single appeal. An immediate interlocutory appeal would only result in unnecessary
6 delay.

7 **III. THE EQUITIES WEIGH IN FAVOR OF RESOLVING ALL ISSUES PRIOR TO APPEAL**

8 Consideration of whether to certify a partial judgment as final under Rule 54(b) requires
9 the Court to consider the equities of allowing an immediate appeal. When evaluating the equities,
10 the court may consider any factor that seems relevant to the particular case. *Angoss II Partnership*
11 *v. Trifox, Inc.*, 2000 WL 288435 (N.D. Cal. May 13, 2000).

12 Gen-Probe is licensed under the '338 patent and has been paying royalties under a
13 reservation of rights during the course of this litigation. See Declaration of R. William Bowen,
14 and Exs. 3 and 4. Thus, as Vysis' asserts in its papers, it is in Gen-Probe's best interest to finally
15 resolve this matter in the most expeditious manner. Gen-Probe strongly disagrees, however, that
16 an interlocutory appeal is the quickest path to a final and complete resolution of this case.

17 An interlocutory appeal is likely to delay the final resolution of this matter for several
18 years. Assuming the appellate process for such an appeal takes two years (*Sure-Safe*, 851 F.Supp
19 at 1476), it would likely be several years more before this case is finally resolved by a trial court
20 determination of validity issues and a subsequent appeal of those issues. Conversely, if a single
21 appeal follows adjudication of *all* issues, this case may be finally resolved in as little as thirty
22 months. See e.g. Stipulation Re Second Amended Pre-Trial Schedule; [Proposed] Order Thereon,
23 Ex. 5 (final pretrial conference set for January 14, 2002).

24 While the detriment to Gen-Probe of an immediate appeal is palpable, the same is not true
25 for Vysis. According to Vysis' moving papers, the only hardship that it will experience if it is
26 denied the right to immediately appeal is the possibility of limited discovery and a possible re-trial

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28 ⁵ There is no indication that the defendant opposed the Rule 54(b) motion referred to in *Trilogy*
Communications, Inc. v. Times Fiber Communications, Inc., 109 F.3d 739 (Fed. Cir. 1997).

1 if an appeal is successful. But these considerations do not justify the delay that would result from
2 an interlocutory appeal, particularly when an appeal is unlikely to be successful. The equities
3 clearly weigh in Gen-Probe's favor and dictate that Vysis' request for immediate entry of
4 judgment under Rule 54(b) be denied.

5 **IV. IN THE EVENT THE COURT CONCLUDES THAT VYSIS IS ENTITLED TO PURSUE AN**
6 **IMMEDIATE APPEAL UNDER RULE 54(B), THE TRIAL ON THIS MATTER SHOULD,**
7 **NEVERTHELESS, PROCEED AS PLANNED**

8 Should the Court certify the order granting partial summary judgment as a final judgment,
9 the Court should deny Vysis' additional request for a stay. Implicit in any order granting Vysis'
10 motion would be a determination that there are few, if any, overlapping issues. That being so,
11 there is no meaningful benefit in delaying the resolution of the trial of this matter.

12 In particular, Gen-Probe contends that the '338 patent is invalid on several grounds that are
13 entirely independent of whether the definition of "amplification" is construed to include specific
14 amplification. By way of example, Gen-Probe is prepared to prove through summary judgment (or
15 trial, if necessary) that the '338 patent is invalid by reason of the inventors' failure to "enable" the
16 practice of the claimed invention as required by 35 U.S.C. § 112. Additionally, Gen-Probe intends
17 to prove that '338 patent is invalid because the claims are either anticipated or rendered obvious by
18 the relevant prior art. None of these defenses depends upon the Court's determination on Gen-
19 Probe's motion for partial summary judgment. No good reason justifies a further delay in
20 resolving these fundamental issues.

21 Moreover, as discussed above, in addition to the lack of any legal or evidentiary basis to
22 stay the trial of the remaining counts, any delay will materially prejudice Gen-Probe. Thus, if the
23 Court is inclined to grant the Rule 54(b) certification request for any reason, it should deny Vysis'
24 motion to stay the case. Alternatively, the Court should impose conditions that are adequate to
25 protect Gen-Probe against the prejudice that it will suffer as a result of the delay, e.g., by
26 conditioning its order on Vysis' agreement that payment of royalties may be made into an escrow
27 account.
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V. CONCLUSION

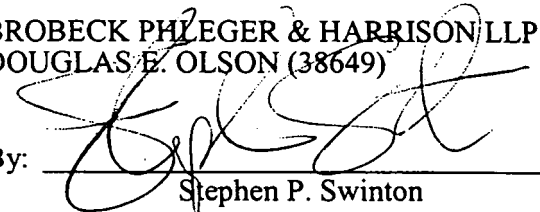
For the foregoing reasons, Vysis' motion should be denied.

Dated: July 10, 2001

COOLEY GODWARD LLP
STEPHEN P. SWINTON (106398)
J. CHRISTOPHER JACZKO (149317)

GEN-PROBE INCORPORATED
R. WILLIAM BOWEN, JR. (102178)

BROBECK PHLEGER & HARRISON/LLP
DOUGLAS E. OLSON (38649)

By: 

Stephen P. Swinton

Attorneys for Plaintiff
Gen-Probe Incorporated

200720 9062560

PROOF OF SERVICE
(FRCP 5)

1 I am a citizen of the United States and a resident of the State of California. I am employed
2 in (County), State of California, in the office of a member of the bar of this Court, at whose
3 direction the service was made. I am over the age of eighteen years, and not a party to the within
4 action. My business address is 4365 Executive Drive, Suite 1100, San Diego, California 92121-
5 2128. On the date set forth below I served the documents described below in the manner described
6 below:

- 7 **1. GEN-PROBE INCORPORATED'S OPPOSITION TO MOTION FOR ENTRY OF FINAL JUDGMENT**
8 **UNDER RULE 54(B);**
9 **2. DECLARATION OF J. CHRISTOPHER JACZKO IN SUPPORT OF OPPOSITION TO MOTION FOR**
10 **ENTRY OF FINAL JUDGMENT UNDER RULE 54(B);**
11 **3. DECLARATION OF R. WILLIAM BOWEN IN SUPPORT OF OPPOSITION TO MOTION FOR FINAL**
12 **ENTRY OF JUDGMENT UNDER RULE 54(B); AND**
13 **4. NOTICE OF LODGMENT IN SUPPORT OF OPPOSITION TO MOTION FOR ENTRY OF FINAL**
14 **JUDGMENT UNDER RULE 54(B)**

- 15 (BY U.S. MAIL) I am personally and readily familiar with the business practice of
16 Cooley Godward LLP for collection and processing of correspondence for mailing
17 with the United States Postal Service, and I caused such envelope(s) with postage
18 thereon fully prepaid to be placed in the United States Postal Service at San Diego,
19 California.
20 (BY MESSENGER SERVICE) by consigning the document(s) to an authorized
21 courier and/or process server for hand delivery on this date.
22 (BY FACSIMILE) I am personally and readily familiar with the business practice
23 of Cooley Godward LLP for collection and processing of document(s) to be
24 transmitted by facsimile and I caused such document(s) on this date to be
25 transmitted by facsimile to the offices of addressee(s) at the numbers listed below.
26 (BY OVERNIGHT MAIL) I am personally and readily familiar with the business
27 practice of Cooley Godward LLP for collection and processing of correspondence
28 for overnight delivery, and I caused such document(s) described herein to be
deposited for delivery to a facility regularly maintained by Federal Express for
overnight delivery.

on the following part(ies) in this action:


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Attorneys for Vysis, Inc.

8 I declare that I am employed in the office of a member of the bar of this court, at whose
9 direction this service was made.

10 Executed on July 10, 2001, at San Diego, California.

11 
12 _____
13 Marisa Salas

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PROOF OF PERSONAL SERVICE

Code Civ. Proc. §§ 1011 and 1013a(1)

I hereby declare:

I am employed in the City of San Diego, County of San Diego, California; I am over the age of eighteen years and not a party to the within cause; my business address is KNOX ATTORNEY SERVICE, 2250 Fourth Avenue, San Diego, CA 92101

On July 10, 2001, I served the within document(s):

1. GEN-PROBE INCORPORATED'S OPPOSITION TO MOTION FOR ENTRY OF FINAL JUDGMENT UNDER RULE 54(B);
2. DECLARATION OF J. CHRISTOPHER JACZKO IN SUPPORT OF OPPOSITION TO MOTION FOR ENTRY OF FINAL JUDGMENT UNDER RULE 54(B);
3. DECLARATION OF R. WILLIAM BOWEN IN SUPPORT OF OPPOSITION TO MOTION FOR FINAL ENTRY OF JUDGMENT UNDER RULE 54(B); AND
4. NOTICE OF LODGMENT IN SUPPORT OF OPPOSITION TO MOTION FOR ENTRY OF FINAL JUDGMENT UNDER RULE 54(B)

on the interested parties in this action by personally hand delivering a copy of said document(s) to the address(es) listed below:

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701 B Street, Suite 1550
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Attorneys for Vysis, Inc.

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct, and that this declaration was executed on July 10, 2001.

SIGNATURE: _____

PRINT NAME: _____

202120 9066560